



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

ANDERSON

Art Unit: 3628

Application No.: 09/775,532

Examiner: Clement, G.

Filed: February 2, 2001

Attorney Dkt. No.: 026732-00009

For: SYSTEM AND METHOD FOR FACILITATING BILLING ALLOCATION WITHIN
AN ACCESS CONTROLLED ENVIRONMENT VIA A GLOBAL NETWORK
SUCH AS THE INTERNET

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

June 7, 2007

Sir:

The Applicant requests review of the Final Office Action mailed February 2, 2007, the period for response being extended to June 7, 2007 by the attached Petition for Extension of Time. This request is not accompanied by an amendment to the currently pending claims. Claims 1-24 are pending in this application. The outstanding Office Action is the second and Final Office Action in this application. Thus, this application qualifies for Appeal.

The Office Action rejects claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Joyce et al. (U.S. Patent No. 6,320,947) in view of Heckard et al. (U.S. Patent No. 6,430,276) and Pickering (U.S. Patent No. 5,684,965). The Applicant submits that the rejection is made in error for at least the reasons set forth below.

Applicant respectfully submits that nothing in the cited art, taken alone or in combination, discloses or suggests a billing facility configured to permit a user to establish a billing allocation scheme between a first party and second party to be used, wherein the billing data indicates a first monetary amount which is to be billed to the first party, and a second monetary amount which is to be billed to the second party, wherein each of the first monetary amount and the second monetary amount are an amount greater than zero, and the first party is different than the second party, as recited in independent claims 1, 6, and 21, and similarly recited in independent claims 11 and 16.

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner failed to show that the cited prior art discloses, suggests or render obvious each and every limitation recited in claims 1-24 of the present invention.

The Office Action admits that Joyce fails to teach a billing facility configured to permit the user to establish a billing allocation scheme between a first party and second party to be used, wherein the billing data indicates a first monetary amount to be billed to the first party and a second monetary amount to be billed to the second party, as recited in independent claims 1, 6, and 21, and similarly recited in independent claims 11 and 16 (Office Action, pages 2-3, 6, 9, 12 and 14-15), and relies on Heckard to disclose or suggest this feature.

However, a closer examination of Heckard reveals that nothing in Heckard discusses or suggests the above-discussed features of the present invention. Heckard teaches a method for concealing a mobile subscriber location information by using location area code regions and sub-regions and determines what level of access to give

to a user on the basis of user identification (Abstract). However, a first subscriber and a second subscriber in Heckard do not correspond to the claimed first party and second party because there Heckard does not discloses or suggests that users are permitted to establish a billing allocation scheme between a first party and a second party to be used to control the billing of services that are provided, wherein the billing data indicates a first monetary amount to be billed to the first party, and a second monetary amount to be billed to the second party. Heckard is entirely silent on these features.

Furthermore, the Examiner admits that Joyce and Heckard fail to explicitly teach that the billing of services is associated with a particular transaction, wherein each of the first monetary amount and the second monetary amount are an amount greater than zero and the first party is different than the second party, as recited in independent claims 1, 6, and 21, and similarly recited in independent claims 11 and 16 (Office Action, at page 3), and relies on Pickering to disclose or suggest these features.

Pickering teaches an automated method and system for consolidating a plurality of individual company charges for a customer with different periodic company billing and payment due dates (Abstract). Pickering merely discloses one customer, and the charges related to that one customer, and does not teach two parties being billed for services of the same transaction. Pickering provides only one party, i.e., the customer, who is to be billed or charged for services, and there cannot be any inequitable distribution of expenses “between a single party.” Accordingly, there is no need in Pickering for a user to establish a billing allocation scheme between at least two different parties where the billing data indicates a first monetary amount associated with the first party, and a second monetary amount associated with the second party, since

the customer of Pickering is the only person of the transaction, and the billing for the customer is billed only to the customer. Moreover, because the charges are always billed to the single customer who used the service, there is no incentive to allow the customer to establish a billing allocation scheme between two different parties. As such, those of ordinary skill in the art at the time the invention was made would not have been motivated to modify the systems and methods described in Joyce, Heckard or Pickering to include the Applicant's claimed billing allocation scheme.

Thus, the combination of Joyce, Heckard and Pickering does not disclose or suggest the Applicant's claimed invention, as set forth in independent claims 1, 6, 11, 16, and 21.

Furthermore, the Examiner alleges that claim limitations that employ phrases of the type "to permit, to perform, to authenticate, to permit, to be used, to consolidate, to facilitate, configured to store, to authenticate, to determine, to communicate, to be billed, related to a transaction, to establish, to maintain" may not distinguish over prior art because they are not positive limitations and only require the ability to do so (Office Action, page 19, lines 8-15). However, the Examiner failed to provide any legal authority to support this allegation, such as a Federal Circuit or a Supreme Court decision.

Applicant respectfully submits a recent Federal Circuit decision indicates that, for example, the phrase "adapted to" does not render the claim indefinite or not amenable to claim construction, which is the requirement to demonstrate indefiniteness. *Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions, P.C.*, 482 F.3d 1347, (Fed. Cir. 2007).

For at least these reasons, the Applicant submits that independent claims 1, 6, 11, 16 and 21 are allowable over the cited art. Therefore, withdrawal of the obviousness rejection and allowance of independent claims 1, 6, 11, 16, and 21 is respectfully requested.

Regarding claims 2-5, 7-10, 12-15, 17-20 and 22-24, the Applicant respectfully submits that each of these claims depends from one of allowable claims 1, 6, 11, 16 and 21, and is therefore allowable for at least the same reasons.

For all of the above reasons, a pre-Appeal Brief review of the outstanding Office Action is respectfully requested, and a favorable decision including allowance of all pending claims is earnestly solicited. In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026732-00009.**

Respectfully submitted,



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Enclosure: Petition for One Month Extension of Time